

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant:	Gregory L. Sundberg	Examiner:	Terri L. Smith
Serial No.:	10/734,088	Group Art Unit:	3762
Filed:	December 11, 2003	Docket No.:	279.646US1
Title:	LEAD HAVING REDUCED LEAD BODY SIZE		

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

In response to the Office Action mailed June 5, 2007 (hereinafter "Office Action") and the Advisory Action mailed August 14, 2007 (hereinafter "Advisory Action"), Appellant respectfully requests pre-appeal review of the rejections in the above-identified application. No amendments are submitted with this request, which is being filed with a Notice of Appeal.

The review is requested because the cited references fail to establish all elements recited in Appellant's claims and *prima facie* obviousness has not been established for at least the reasons set forth below. Therefore, Appellant respectfully submits that the only logical conclusion is that the present claims are found to be patentable over the cited references.

**1. Claims 1-3, 5-7 and 23-24:**

Claims 1-3, 5-7 and 23-24 were rejected under 35 USC § 102(e) as being anticipated by Gardeski et al. (US Patent No. 7,130,700) (hereinafter "Gardeski"). Appellant respectfully traverses on the ground that Gardeski fails to recite each element of the claims.

Appellant's claim 1 recites a lead comprising "one or more fillers disposed within [a] tubular lead body, the one or more fillers are disposed adjacent to the insulated at least one conductor and include one or more recesses; and the at least one conductor is disposed outside the one or more recesses." Appellant cannot find in Gardeski any recitation of a lead comprising a conductor (or conductors if more than one)<sup>1</sup> that is/are disposed outside the recess portion (or portions if more than one) of a lead body filler, as claimed. Rather, Gardeski recites a lead having elongated members, such as conductors, each of which are received by one of a plurality of recesses or lumens in a filler.<sup>2</sup> In fact, the Office Action appears to recognize that the

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<sup>1</sup> "[A]nyone with even the most rudimentary understanding of the English language understands 'at least one piezo-electric crystal means lodged within said component means,' to mean one or more crystals." *Kistler Instrumete AG v. United States*, 628 F.2d 1303, 1318, 211 USPQ 920 (Ct. Cl. 1980).

<sup>2</sup> For example, Gardeski expressly states:

conductors of Gardeski are disposed in recess portions of the asserted filler. (*See* Office Action at 5, stating element “121” is interpreted as a recess and element “150”, an insulated conductor, is disposed in recess “121”.) Because Gardeski does not recite a conductor (or conductors if more than one) that is/are disposed outside the recess (or recesses if more than one) of a lead body filler, as recited in Appellant’s claim 1, Gardeski does not anticipate claim 1.<sup>3</sup>

*Claim 6:*

Additionally, regarding claim 6, Appellant cannot find in Gardeski any recitation of one or more fillers “generally C-shaped,” as recited in such claim. The Office Action asserts that Gardeski recites a filler including “one or more generally C-shaped recesses,” but not that each filler itself has a general, overall C-shape, as claimed by Appellant.<sup>4</sup> (Office Action at 5.)

Because Gardeski does not recite one or more fillers having a generally C-shape, as recited in Appellant’s claim 6, Gardeski does not anticipate such claim.

**2.** *Claims 1-3, 5-7 and 23-25:*

Claims 1-3, 5-7 and 23-25 were rejected under 35 U.S.C. § 102(e) as being anticipated by Cross, Jr. et al. (US Patent No. 5,935,159) (hereinafter “Cross, Jr.”). Appellant respectfully traverses on the ground that Cross, Jr. fails to recite each element of the claims.

Appellant cannot find in Cross, Jr. any recitation of a lead comprising a conductor (or conductors if more than one)<sup>5</sup> that is/are disposed outside the recess portion (or portions if more than one) of a lead body filler, as recited in claim 1. Rather, Cross, Jr. recites a lead filler with longitudinally extending groove recesses in which conductors are located.<sup>6</sup> Because Cross, Jr.

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The first tubular member and the second tubular member form a plurality of lumens extending from a proximal end through the distal end of the multibody lumen, the plurality of lumens receiving elongated members therein.

(Gardeski at col. 3, lns. 35-40; col. 3, lns. 52-54.)

According to the present invention, each of conductors 150-156 are positioned within a respective slot portion 119 of lumens 140a-d formed by inner insulating member 134.

(Gardeski at col. 15, lns. 61-63.)

<sup>3</sup> According to the Federal Circuit, “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 200 USPQ 303, 313 (Fed. Cir. 1983).

<sup>4</sup> According to Merriam-Webster, “generally” is defined as “with regard to an overall picture.” <http://www.merriam-webster.com/dictionary/generally>

<sup>5</sup> *See* note 1, *supra*.

<sup>6</sup> For example, Cross, Jr. expressly states:

does not recite a conductor (or conductors if more than one) that is/are disposed outside the recess (or recesses if more than one) of a lead body filler, as recited in Appellant's claim 1, Cross, Jr. does not anticipate such claim.

*Claims 2-3:*

Additionally, regarding claims 2-3, Appellant cannot find in Cross, Jr. any recitation of one or more fillers including one or more recesses wherein "the one or more recesses include compression features," as recited in claim 2, or wherein "the compression features [of the one or more recesses] include compression waves," as recited or incorporated in claim 3. The Office Action has previously asserted that the "radially extending portions (180, 182, 184, 186)" of Cross, Jr. comprise the compression features and the longitudinally extending grooves "(190, 192, 194, 196)" of Cross, Jr. comprise the compression waves. (Office Action dated July 24, 2006 at page 3). However, Cross, Jr. expressly recites:

[L]ongitudinally extending grooves in which conductors are located and an outer tubular member, encasing the core and conductors . . . [t]ube 100 has an inner diameter approximately equal to the outer diameter of core 102.  
(Cross, Jr. at Abstract; col. 3, lines 25-26). Appellant submits the disposition of the conductors into the grooves of Cross, Jr. in conjunction with approximately equal inner tube diameter and outer core diameter does not allow for the presence of one or more recesses nor the recess-associated compression features, as claimed.

Because each element of Appellant's claims 2-3 cannot be found in Cross, Jr., such references does not anticipate such claims.

*Claim 6:*

Additionally, regarding claim 6, Appellant cannot find in Cross, Jr. any recitation of one or more fillers "generally C-shaped," as recited in such claim. The Office Action asserts that Cross, Jr. recites a filler including "one or more generally C-shaped recesses," but not that the filler itself has a general, overall C-shape, as claimed by Appellant.<sup>7</sup> (Office Action at 5.)

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The lead body is formed of separate parts including an extruded core or strut member which is provided with longitudinally extending grooves in which conductors may be located and an outer tubing member, surrounding the core.  
(Cross, Jr. at col. 1, lns. 21-25; *see also* Abstract and col. 2, lns. 52-56.)

<sup>7</sup> See note 4, *supra*.

Because Cross, Jr. does not recite one or more fillers having a generally C-shape, as recited in Appellant's claim 6, Cross, Jr. does not anticipate such claim.

3. *Claim 21:*

Claim 21 was rejected under 35 USC § 103(a) as being unpatentable over Gardeski. Appellant respectfully requests reversal of this rejection on the ground that there is no *prima facie* case of obviousness.

Appellant's claim 21 recites a lead wherein "a flexibility of the one or more fillers is greater than a flexibility of the tubular body." The Office Action expressly admits that Gardeski fails to recite such claim elements, but asserts that modifying the inner insulating member of Gardeski to include a flexibility greater than a flexibility of the tubular body would have been "an obvious design choice." (Office Action at 6.) Appellant submits that such assertion *prima facially* fails to satisfy the requirements of 35 USC § 103, as Gardeski apparently teaches against the claimed subject matter.<sup>8</sup>

Because Gardeski teaches against the asserted obvious design choice, such assertion is improper and fails to *prima facie* establish all elements recited in Appellant's claim 21.

4. *Claim 26:*

Claim 26 was rejected under 35 USC § 103(a) as being unpatentable over Cross, Jr. in view of Gardeski. Appellant respectfully requests reversal of this rejection on the ground that there is no *prima facie* case of obviousness.

The proposed combination of Cross, Jr. and Gardeski is improper and fails to establish all elements recited in Appellant's claim 26, at least for the teaching away reasons asserted on pages 13-14 of the Appellant's Response dated August 6, 2007 (hereinafter "Paper No. 1"). The Advisory Action states the teaching away remarks by Appellant in Paper No. 1 are not persuasive as portions of Gardeski "that Examiner did not rely on to make the combination"

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<sup>8</sup> For example, Gardeski expressly states:

For example, in one embodiment for providing enhanced torque transfer properties, inner insulating member 134 is formed from a polyketone, such as polyaryletherketone, available commercially under the tradename PEEK-Op-tima®, from Inyibio™, or polyetheretherketone available from Victrex-USA. The outer insulating member 132 may be formed from silicone.

(Gardeski at col. 15, lns. 1-7; *see in conjunction* col. 10, ln. 67 – col. 11, ln. 2 and Advisory Action at 2, recognizing an inversely proportion relationship exists between torque and flexibility.) Thus, in contrast to Appellant's claim 21, Gardeski recites an inner filler member having enhanced torque transfer and therefore reduced flexibility properties.

were used.<sup>9</sup> (Advisory Action at 2.) The Advisory Action further states, "Cross, Jr. teaches the structure . . . set forth in the present invention, but was silent on exactly what type/kind of conductors were used. Therefore, the Examiner merely needed to find art in the same field of endeavor the [sic] taught the specific conductors as claimed." (*Id.*) Appellant points out that Cross, Jr. in fact states, "[i]n th[e] embodiment [cited by the Office Action and Advisory Action], the conductors may similarly be formed of bundled or stranded wire."<sup>10</sup> Appellant further remarks that the US Supreme Court recently stated, "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art."<sup>11</sup>

Because the combination of Cross, Jr. and Gardeski teach away<sup>12</sup> from the Appellant's claimed combination of an outer surface portion of a cable conductor contacting an outer surface portion of a coiled conductor, such combining of references is improper and fails to establish all elements recited in claim 26.

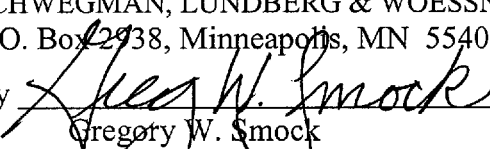
### CONCLUSION

For at least these reasons, Appellant respectfully submits that claims 1-7 and 21-27 are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited and encouraged to telephone Appellant's attorney Gregory W. Smock at (612) 373-6956 to facilitate prosecution of this application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,  
SCHWEGMAN, LUNDBERG & WOESSNER, P.A.  
P.O. Box 2938, Minneapolis, MN 55402 (612) 373-6956


Date OCTOBER 5, 2007

By

  
Gregory W. Smock  
Reg. No. 60,208

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 5 day of October 2007.

NICOLE JAL  
Name

  
Signature

<sup>9</sup> According to the Federal Circuit, a reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered. (*See Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).)

<sup>10</sup> Cross, Jr. at col. 4, lns. 24-26.

<sup>11</sup> *KSR International Co. v. Teleflex Inc.*, 550 U. S. \_\_\_\_ (2007).